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In the Supreme Court of the United States

OCTOBER TERM, 1962

No. 596

SEARS, ROEBUCK & CO. and
PARKER MANUFACTURING COMPANY,
PETITIONERS,

v.

HAROLD T. JONES and
THE PETERSEN MANUFACTURING COMPANY,
INC.,
RESPONDENTS.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT

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In the
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No.

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INC.,
RESPONDENTS.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT

Petitioners Sears, Roebuck & Co. and Parker Manufacturing Company pray that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Tenth Circuit, entered in the above-entitled case on September 12, 1962.

Opinions Below

The Opinion of the District Court for the District of Colorado is reported at 187 F. Supp. 293, 127 U.S.P.Q. 411, and is printed in the Record herein (pp. 17-24). The Opinion of the Court of Appeals is reported F.2d , 135 USPQ 149, and is printed in Appendix A hereto.

Jurisdiction of this Court

The judgment of the Court of Appeals was entered on September 12, 1962. The jurisdiction of this Court is invoked under 28 U.S.C. Sec. 1254(1).

Questions Presented

I. Whether a patentee, who fails to disclose to the Patent Office an alternative structure as an embodiment of his invention in his patent application, and whose claims do not cover the alternative structure, which the Court finds as a fact he had embodied in a working model while his patent application was pending, as required by the Patent Statutes then in force, specifically R.S.4888, can nevertheless recapture the alternative structure by having it declared to be the mechanical equivalent of the structure originally disclosed to the Patent Office as his invention?

II. Whether a patentee, who fails to disclose to the Patent Office and claim an alternative structure as an embodiment of his invention in his patent application, as required by R.S.4888 then in force, and who then broadens his patent claims to cover such alternative structure more than one year after such alternative structure has been in public use by a third party, as prohibited by R.S.4886 then in force, can nevertheless recapture the alternative structure by having it declared to be the mechanical equivalent

of the structure originally disclosed to the Patent Office as his invention?

III. Whether the doctrine of equivalents can be resorted to by the Federal Courts to find infringement through interpretation of claims in a patent by an alternative structure which was not disclosed in the original patent application as filed, in violation of R.S.4888, and which has been outlawed by being in public use by a third party more than one year before a claim seeking to cover such alternative structure is filed, in violation of R.S.4886?

IV. Whether the doctrine of equivalents as enunciated by this Court in *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 339 U.S. 605 (1950) can be resorted to by the Federal Courts to find infringement through interpretation of claims in a "paper" patent disclosing an Article of Manufacture which has never been commercially manufactured by the patentee by an alternative structure which was not disclosed in the original patent application as filed, as against third parties who have independently developed such similar alternative structures?

V. Whether the doctrine of equivalents can be resorted to by the Federal Courts to find infringement through construction of the claims in a patent by an alternative structure not disclosed in the original patent application as filed, and which claims if otherwise broad enough to cover such alternative structure would be invalid for indefiniteness, and because functional, and because not supported by the patent disclosure?

VI. Whether the doctrine of equivalents can be resorted to by the Federal Courts to construe patent claims broadly as covering a "pioneer invention" and thus to cover an alternative structure not disclosed in the patent application as filed, and which, when so construed, are broad enough to cover as "equivalents" thirty other alternative struc-

tures independently developed since such patent application was filed, which achieve the same mechanical result?

VII. Whether a patent can be held valid as disclosing an invention not obvious to the man skilled in the art, and as a "pioneer patent" entitled to a broad range of equivalents, which discloses a mechanical structure conceived independently of each other by six mechanics, and which is held to cover as an "equivalent" an alternative structure further independently conceived by three other mechanics?

VIII. Whether a patent disclosing and claiming a simple, well-known form of pivoted release lever for "breaking the toggle" in a Toggle Wrench can be held to be a "pioneer invention" and hence entitled to a broad range of "equivalents" to cover other forms of pivoted release levers independently developed, wherever mounted on the Wrench and which achieve the same result.

The basic question presented by this case is *undue expansion of the patent monopoly*—whether the doctrine of equivalents can be resorted to to expand the patent monopoly, contrary to the patent statutes and settled principles of patent law.

Constitutional Provision Involved

The Congress shall have Power . . . To promote the Progress of Science and Useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries. United States Constitution, Art. 1, Sec. 8.

Statutory Provisions Involved

The statutory provisions involved are the following provisions of the Patent Laws of the United States in effect

on July 4, 1950[1] prior to the new Patent Act of 1952, which codified the previously existing law:

R.S.4888—Title 35, U.S.C. Sec. 33; (now since 1952, embodied in 35 USC. Sec. 111 and 112)

R.S.4886—Title 35 U.S.C. Sec. 31; (now since 1952, embodied in 35 USC Sec. 102(b)

R.S.4892—Title 35 U.S.C. Sec. 35; (now since 1952, embodied in 35 USC. Sec. 115)

These statutory provisions are printed in Appendix B, hereto, P. 33.

Also involved is Rule 70 of the Rules of Practice of the Patent Office then in force (1944 to 1956) (now embodied in present Rule 18)—printed in Appendix B, p. 34.

Statement of the Case

The Jones patent in suit No. 2,514,130[2] granted July 4, 1950 relates to a Quick Release Lever for a Toggle or Locking Wrench. The Toggle Wrench itself is old, well known, and in the public domain. Respondent Petersen Mfg. Co. has manufactured and sold millions of them. The Toggle Wrench was the subject of Petersen patent No. 1,489,458, granted April 8, 1924, and which expired April 8, 1941. Respondent Petersen Manufacturing Company since September 1956 has been and is now exclusive licensee under the Jones patent in suit. The Toggle Wrench utilizes the principle of the toggle joint to provide a locking action on the movable jaw of the wrench to hold the work-piece in a vise-like grip, when the central pivot point of the toggle joint crosses the "dead center line". Great force is then

[1] The date of issuance of the Jones patent in suit No. 2,514,130.

[2] Because the Jones patent is not reproduced in the Record, it is reproduced herein in Appendix C.

required to move the central pivot point back across the "dead center line", and thus to "break the toggle" and open the movable jaw of the Wrench. This usually required two hands and was very difficult in restricted spaces. The Jones patent in suit discloses *one form* of Quick-Release Lever to move the central pivot point back across the "dead center line" and "break the toggle". It comprises a release lever pivotally mounted within the channel of the movable handle, and which has a camming portion which can be moved by a finger of one hand to engage or cam against the toggle link, and thus move the central pivot point back across the "dead center line", and unlock the Wrench. Actually, Jones' Release Lever disclosed is even more specific, having a loose pivot permitting the lever to be rocked in two directions, both toward and away from the Fixed Handle, to "break the toggle". Jones' Release Lever is thus a simple lever of the First Class, with the fulcrum (or pivot) between the Weight and the Power.

The lever is one of the oldest mechanical contrivances known to man. The principles of the lever were well known to the Greeks and Egyptians in the pre-Christian era. The pyramids were built by use of the lever. The great mechanical advantage obtainable from a pivoted or fulcrumed lever of the First Class is well known to every mechanic and high school Physics student. The claw of a hammer used to pull nails, and the crow-bar are every day examples. To work efficiently in a Toggle Wrench the pivoted Release Lever should apply its force directly upon, or as closely to, the central pivot point of the toggle joint, as possible, to readily move it across the "dead center line" to break the toggle. But apart from that, the pivoted Release Lever to "break the toggle" in a Toggle Wrench can take many forms. Some thirty or more forms, since Jones' filing date of June 20, 1944, and many filed before the Jones patent issued, are shown in the patented art

(Defts' Book of Patents, Defts' Exh. G and H, physical exhibits).

In Appendix C we show a drawing of the present Petersen Toggle Wrench, now in the public domain, and below it, the Petersen embodiment of the Pivoted Release Lever of the Jones patent in suit—which the District Court and Court of Appeals held to be a "pioneer invention".

In April 1956 Petitioner Parker Company *independently* developed[3] through its engineer, Gabriel La Pointe, a second form of Quick Release Lever for a Toggle Wrench, which it has manufactured and sold to its customer, the petitioner, Sears, Roebuck & Co., under the latter's CRAFTSMAN trademark. The petitioner Parker Company is defending this suit under a standard hold-harmless agreement against patent infringement, required of all Sears, Roebuck's suppliers. Before manufacturing its Parker Wrench, Parker Company asked its patent counsel to conduct a patent infringement search, which included the

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[3] The evidence is conclusive that Parker's Wrench with Quick Release was *independently* developed. Parker was first asked to bid on Toggle Wrenches by Sears Roebuck on March 9, 1956 (Maerlender Exh. 5-A, Rp. 488). Parker's engineer Gabriel La Pointe immediately designed Toggle Wrenches with *four* different forms of Release Levers — La Pointe Drawings dated April 2, 1956 and April 9, 1956 (Rp. 599 and 601). *The second Drawing in Fig. IV* (Rp. 601) *shows the Parker form of Quick Release Lever here in suit.* Toggle Wrenches with Quick Release Levers had been on the market and extensively sold for many years previously — the Basford Wrench (in Interference with Jones) since June 1947 (Mixter, Rp. 792) and the Seymour Smith Wrench since August 1948 (Smith Rp. 605; 608). But Sears Roebuck did not want a Toggle Wrench with the Quick Release feature, and in 1956 Parker supplied only the standard Toggle Wrench. On March 15, 1957 Petersen advertised its Toggle Wrench with a Quick Release (Rp. 683) and Sears, Roebuck to compete with Petersen, asked Parker to supply one (Maerlender Rp. 444-5). Parker did so, reverting to its original design shown in La Pointe drawing in Fig. IV (Rp. 601) — shipments starting November 27, 1957 (La Pointe Rp. 219-223; Priest Rp. 713). There is, and can be, no contrary finding on this point.

Jones patent in suit, and petitioner's patent counsel reported the Jones patent in suit clearly not infringed (Rp. 25-27). Later Petitioner Parker Company found that its form of Quick Release Lever did infringe the copending Waterbury patent No. 2,574,676, granted November 13, 1951, and filed November 22, 1946 and accordingly purchased that patent, which it has since reissued, as Reissue No. 24,465.

A drawing of the Parker CRAFTSMAN Wrench appears herein, Appendix C. As the drawing shows, Parker's Release Lever is a bifurcated lever pivotally mounted *on the toggle link*, which has a camming portion which engages and cams against *the movable handle*, when the Release Lever *is moved toward the Fixed Handle*, thus pulling the central pivot point back across the "dead center line", to break the toggle. The Parker Quick Release Lever thus accomplishes the same result of breaking the toggle, but by different mechanism operating in a different manner. The District Court, however, found it to be the "equivalent" of this Jones Quick Release Lever, and the Court of Appeals has affirmed.

Claims 1, 4 and 5 of the Jones patent are in suit. Claims 1 and 4 are specific to Jones type of Release Lever (i.e. pivotally mounted on the Movable Handle and camming against the Toggle Link). Both the District Court and Court of Appeals concede that claims 1 and 4 did not read directly upon Petitioners' accused device. But both Courts held Jones' Quick Release Lever to be a "pioneer invention", entitled to a broad range of "equivalents", and that Parker's Release Lever achieved the same result by a mere "reversal of parts", was the equivalent thereof, and hence infringed claims 1 and 4 (Opinion, Appendix A, pp. 28-29. Thus the Jones patent was held to cover inventions Jones did not disclose, and did not claim, and as construed

by them, the two Courts below have rewritten the Jones patent into a patent the Patent Office did not grant. In fact the Court of Appeals even rewrote the Jones' claims in functional form, indicating that that was the scope and breadth of equivalency the Jones patent was entitled to, in view of its rank as a "pioneer invention" (Appendix A, p. 28).

Jones' claim 5 stands on an even worse footing. The record and File History of the Jones patent shows that Jones' claim 5 was filed on December 6, 1949, while his patent application was pending, expressly to cover the Parker type of Release Lever (i.e. pivotally mounted on the Toggle Link, and camming against the Movable Handle) embodied in a Toggle Wrench manufactured and publicly sold by Seymour Smith & Sons Co. of Oakdale, Connecticut (an independent inventor)[4] since August 1948 and *more than one year after Jones himself had bought such a Wrench from Seymour Smith on November 4, 1948 and his patent attorneys sought to cover the Seymour Smith Wrench expressly.* This public sale of the Seymour Smith Wrench more than a year before Jones filed his claim 5 is conceded (Opinion, Appendix A, p. 30). Jones' claim 5 is thus clearly invalid on two counts:

1) It is not supported by Jones' disclosure as required by R.S.4888.

2) It is outlawed by seeking to cover an alternative structure more than one year after the public use and sale of such structure in violation of R.S. 4886, and as proscribed by this Court in *Muncie Gear Works, Inc. v. Outboard Marine & Mfg. Co.*, 315 US 759 at 768, 86 L.Ed. 1171 (1941).

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[4] Smith & Erikson patent No. 2,598,650, granted May 27, 1952, and filed July 28, 1948.

But the Courts below held that these protective rules of the patent law did not apply because the Seymour Smith (and hence Parker) type of Release Lever "was within the clear range of equivalency" of the Jones Release Lever (Opinion, Appendix A, P. 31). Thus Jones' claim 5 was held valid and infringed.

In sustaining "equivalency" of the Parker type of Quick Release Mechanism to that of the Jones patent, the Court of Appeals further relied on the District Court's finding that Jones had constructed a model plier-type wrench having a release lever pivoted on the toggle link, like the Parker & Seymour Smith Wrenches while his (Jones') patent application was pending in the Patent Office (Opinion, Appendix A, P. 30-31). But if true, this Finding destroys Respondent's case—for there was then no excuse whatever for Jones' not including this alternative structure in a separate, or continuation-in-part application, and thus disclosing it to the Patent Office as his invention, as R.S. 4888, and Patent Office Rule 70 then in force, required.

The decisions of the Courts below and their grievous misapplication of the doctrine of Equivalents herein will have many unfortunate results. They have held a "paper" patent disclosing a ridiculously simple and trivial mechanical improvement in an old and well known Toggle Wrench to be a "pioneer invention" entitled to a broad range of equivalents—making a joke of that term. They have allowed Jones to recapture by resort to the doctrine of equivalents an alternative structure which Jones did not disclose, nor claim in claims 1 and 4, and while claimed in claim 5, claim 5 is clearly invalid because of more than one year's public use and sale of the alternative structure by an independent inventor, Seymour Smith. They have also applied their broad range of equivalents against the Petitioner Parker, who also *independently* developed its alternative structure, and whose patent attorney in good faith

had advised Parker its Wrench did not infringe the Jones patent, construing its claims of the Jones patent in the light of its disclosure and specifications, in accordance with settled rules of patent law. The Courts' application of the doctrine of equivalents has been so broad as to render the Jones patent indefinite and functional, and to make it impossible for any patent attorney to advise his client with certainty what the limits of the Jones patent are, and what Quick Release Mechanism would not be held to infringe the Jones patent as an "equivalent", if it achieves the same result. The Toggle Wrench industry thus has no means of knowing what the limits of the Jones patent are and some thirty independently developed structures are thus held under a cloud. The final result of the Courts' decisions is to extend the effective monopoly of Toggle Wrench manufacture held by the Respondent Petersen Manufacturing Company, from 1924 to 1941, for a new period from September 1956, when it acquired its Interim exclusive license from Jones, to July 4, 1967 when the Jones patent finally expires.[5] Because of the Courts' decisions herein, no Toggle Wrench manufacturer dares risk making a competing Wrench with a Quick Release Lever.

Reasons for Granting the Writ

1. The basic problem presented by this case is *undue expansion of the patent monopoly*—this time by improper application of the doctrine of equivalents. The Courts below have uncritically and improperly applied the doctrine to a fact situation herein to which it properly does not apply. The decisions of the Courts below are thus con-

[5] The permanent Jones-Petersen License (Rp. 280-286) required Jones to terminate the existing licenses to Basford Company and Seymour Swith, and not to license anyone else — Par. 12. No competition was to be permitted from any source.

pletely contrary to existing statutory law, and in conflict with the decisions of this Court, and other Courts of Appeal. The Courts below have thus applied the broad range of equivalents accorded a "pioneer invention" to a situation involving the following facts, and results, to which it properly has no applicability:

a) The Jones patent discloses a ridiculously simple pivoted lever, the mechanical advantage of which is well understood and known in the prior art in analogous wrenches and vises.

b) The alternative structure found to be a mechanical equivalent is not disclosed in the Jones patent.

c) The alternative structure is not claimed in the Jones patent, except in claim 5 which is clearly invalid because of more than one year's public use of the same alternative structure by an independent inventor Seymour Smith.

d) Jones was found to have made a model of the alternative structure while Jones patent application was pending, but failed to file a separate, or continuation-in-part application disclosing it, as the Patent Laws (R.S. 4888) required.

e) The Jones patent is a "paper" patent, the Wrench it discloses never having been commercially manufactured, even today.

f) The Petitioner Parker was an independent inventor, the Parker Toggle Wrench with Quick Release being originally developed in April 1956 by Parker's engineer, Gabriel LaPointe, before Parker or LaPointe had any knowledge of the Jones patent.

g) The patentee Waterbury, whose patent No. 2,574,676, granted November 13, 1951 and filed November 22, 1946, while the Jones patent was pending, was purchased by Petitioner Parker because of infringement, also disclosed the same alternative structure now held

to be the mechanical equivalent of Jones' structure, and was also an independent inventor.

h) The Release structure disclosed by Jones in his patent and held to be a "pioneer invention" was also independently developed by six mechanics including Jones and Petersen (R.p. 153) and the alternative structure held to be the mechanical equivalent was independently developed by three other mechanics Seymour Smith, Waterbury, and Parker's engineer, La Pointe.

i) The Jones patent when given the broad range of equivalents accorded a "pioneer invention", then becomes invalid for indefiniteness contrary to R.S. 4888.

j) The Jones patent when given the broad range of equivalents accorded a "pioneer invention" then becomes invalid for functional claiming—contrary to *Halliburton Oil Well Cementing* v. *Walker* 329 US 1 at 12 (1946) and *General Electric Co.* v. *Wabash Appliance Co.* 304 US 364 at 368-9 (1937)—because covering any one of thirty or more Quick Release Mechanisms independently developed since the Jones application was filed in June 1944, which achieve the same result of "breaking the toggle" in a Toggle Wrench, and making it impossible for any patent lawyer to know what the limits of the Jones patent are, and to know what structures the Courts in the Tenth Circuit will regard as "equivalents".[5a]

2. The problems presented by the District Court's and Court of Appeals' decision below are due entirely to the decision of this Court in *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 339 US 605 (1950)—relied on in Respondents' Briefs in the Courts below, which quoted extensively

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[5a] *In fact the Court of Appeals (Opinion P. 28) interprets claim 5 to cover any release lever pivotally attached to any part of the Wrench, and which, by camming means, opens the jaws.*

from the Majority Opinion of this Court (p. 607-8). But the Majority Opinion abundantly made it clear that the doctrine of equivalents was applied therein because there was no showing that the manganese silicate used in the welding flux *was the result of independent invention, and not mere copying and evasion of the patent.* Mr. Justice Jackson said (p. 612):

> "Without some explanation or indication that Lincolnweld (the accused material) was developed by independent research, the trial court could properly infer that the accused flux is the result of imitation rather than experimentation or invention."

And see P. 611, and 33 6 US at p. 276 (1948). But not noting this distinction, the District Court and Court of Appeals in the instant case have uncritically applied this same rule of equivalents to the situation herein, where it has no proper application, where the Petitioner Parker was an independent inventor, was the assignee of a second independent inventor (Waterbury), and the beneficiary of the intervening rights of a third independent inventor (Seymour Smith) all of whom independently conceived the alternative form of Quick Release Mechanism held to be the "equivalent" of the Jones structure, and each of whom was an independent inventor as equally deserving of the protection of the Courts as Jones was.

Further, the manganese silicate held to be equivalent was at least disclosed in the patent. But in the case at bar, the alternative structure held to be the equivalent of the Jones structure was not even disclosed, although the Court found as a fact that it could have been.

The evils which Justices Black and Douglas forecast in their dissenting Opinion (p. 612) as the result of the Court's decision therein have now come to pass. Mr. Justice Black's

language therein applies precisely to this case. Mr. Justice Black said (p. 617):

> "The Court's ruling today sets the 'stage' for more patent 'fraud' and 'piracy' against business than could be expected from faithful observance of the congressionally enacted plan (R.S. 4888 and 4916) to protect against judicial expansion of precise patent claims. *Hereafter a manufacturer cannot rely on what the language of a patent claims. He must be able, at the peril of heavy infringement damages, to forecast how far a court relatively unversed in a particular technological field will expand the claims' language after considering the testimony of technical experts in that field.* To burden business enterprise on the assumption that men possess such a prescience bodes ill for the kind of competitive economy that is our professed goal."

And see Mr. J. Douglas' separate dissenting opinion (p. 618). Relying upon the lack of disclosure and the limitations in Jones' claims herein and the opinion of their patent attorney that under settled rules of patent construction the Wrench did not infringe the Jones patent, the Petitioner Parker has commercially manufactured the accused Wrench since 1957. Now at its peril Petitioner Parker must forecast what other Quick Release Devices the Courts below will decree to be "equivalents" of this "pioneer invention".

This Court for many years has frequently dealt with the problems involved in expanding patents and claims to cover intervening structures made by independent inventors, and has imposed limitatios of time and scope on such expanded coverage, and has unfailingly sought to protect the rights of the public and the independent inventor against unjust expansion of the patent monopoly. The reissue cases are an illustration in point. In *Sontag Chair Stores Co. Ltd.* v. *National Nut Co.*, 310 US 281 (1939) this Court by Mr. Justice McReynolds said (p. 293-294):

"In the case under consideration the patentee might have included in the aplication for the original patent, claims broad enough to embrace petitioner's accused machine, but did not. This "gave the public to understand" that whatever was not claimed "did not come within his patent and might rightfully be made by anyone". *The enlarged claims were presented with knowledge of the accused machine and with definite purpose to include it.*

Recapture within two years (now one year) of what a patentee dedicates to the public through omission is permissible under specified conditions, but not, we think, 'at the expense of innocent parties.' Otherwise, the door is open for gross injustice to alert inventors and baffling uncertainty will hinder orderly development of useful arts."

And see:

Miller v. *Brass Co.*, 104 US 350 at 354 (1881)
Mahn v. *Harwood*, 112 US 354 at 360-361 (1884)

Another illustration of this Court's solicitude for the right of the public and the independent inventor against unjust enlargement of patent claims appears in *Chicago & Northwestern Railway Co.* v. *Sayles*, 97 US 554 at 563, 24 L.Ed. 1053 (1878).

The interests of the independent inventor and the public in these situations have thus invariably been protected by this Court. But the Courts below by their application of the doctrine of "equivalents" in their decisions herein, have held such interests no longer worthy of protection, being grievously misled by the decision of this Court in the *Graver Tank case.*

We do not contend that the doctrine of equivalents has no place in the patent law. But, as an equitable doctrine to prevent injustice, it obviously cannot be applied to cause injustice, and against innocent parties, and in conflict with

the requirements of R.S.4888 and R.S.4886, and the rules against indefiniteness and functional claiming, and File-Wrapper Estoppel—as the Courts below have done. The doctrine must certainly be limited to equivalents of the actual invention *disclosed and claimed* in the patent—as the Patent Office did in limiting the Five-Party Interference to Release Levers of the Jones type, and did not extend it to include the copending Smith-Erikson and Waterbury patent applications showing the alternative structure. Otherwise the requirements of R.S.4888 (and its successor statute 35 U.S.C. Sec. 111 and 112) are completely nullified. The proper application and the limits of the doctrine of Equivalents urgently require re-appraisal. The hopeless confusion caused by the decisions of the Courts below can only be settled by this Court.

3. The decisions of the Courts below, in holding that the patentee Jones, who failed to disclose to the Patent Office the alternative structure as an embodiment of his invention in his patent application, and who filed his claim 5 in an attempt to cover such alternative structure (although not supported by his disclosure) more than one year after such alternative structure had been in public use by Seymour Smith & Co., could nevertheless recapture the alternative structure by finding it to be the mechanical equivalent of the structure originally disclosed to the Patent Office, and thus infringe the Jones patent, are in conflict with R.S.4886 then in force, and with the following decisions of this Court:

Muncie Gear Works, Inc. v. *Outboard Marine & Mfg. Co.*, 315 US 759 at 768, 86 L.Ed. 1171 (1941)

Schriber-Schroth Co. v. *Cleveland Trust Co.*, 305 US 45 at 57, 83 L.Ed. 34 (1938)

Powers-Kennedy Contracting Corp. v. *Concrete Mining & Conveying Co.*, 282 US 175 at 185-6; 75 L.Ed. 278 (1938)

Exhibit Supply Co. v. *Ace Patents Corp.*, 315 US 126 at 136-7; 86 L.Ed. 736 (1941)

Schriber-Schroth Co. v. *Cleveland Trust Co.*, 311 US 211 at 220-221 (1941)

Weber Electric Co. v. *E. H. Freeman Electric Co.*, 256 US 668 at 677-8 (1920)

The Courts below have thus misapplied the doctrine of equivalents to recapture an alternative structure otherwise prohibited to the patentee by law, and thus to circumvent the Patent Laws.

4. The Courts below in holding the Jones patent to be a "pioneer invention" ignored the fact that four other mechanics simultaneously disclosed the Jones type of Quick Release Mechanism, and were placed in a Five-Party Interference by the Patent Office while the Jones application was pending, which was won by Jones. (Rp. 280; 592). Two other mechanics, Smith-Erikson,[6] and Waterbury[7] also simultaneously disclosed the present Parker Type of Quick Release Mechanism while the Jones application was pending, and quite significantly, the Patent Office did not include them in the Interference—obviously because Jones' claim 1 (the Count in Interference) did not read on their structures. Thus six persons, including Petersen (Rp. 153), independently of each other conceived the idea of the Jones type of Quick Release Lever, and three other persons, including Parker's engineer, La Pointe, independently of Jones and each other, also conceived the idea of the Seymour Smith type of Quick Release Lever, and the alternative structure now held to be the "equivalent" of Jones' Quick Release. In so doing, the Courts below then failed to apply the settled rule that when many persons, inde-

[6] Smith-Erikson patent No. 2,598,650, owned by Seymour Smith Co.

[7] Waterbury patent No. 2,574,676, now Reissue No. 24,465 owned by Parker Mfg. Co.

pendently of each other, conceive the same or alternative solutions of a mechanical problem, it indicates that the solution was obvious to persons having ordinary skill in the art, and does not involve patentable invention—35 U.S.C. Sec. 103.[8] Obviously in such situation the Jones Quick Release Lever cannot be a "pioneer invention", justifying the application of a broad range of equivalents, and the rule of equivalents should have been limited to the actual structure disclosed, as the Patent Office did in declaring the Interference.

5. The Courts below further failed to perceive that the Jones patent in suit is entirely a "paper patent"—under settled law entitled to only a narrow range of "equivalents" specific to the structure disclosed—and not the broad range of equivalents applied. No Toggle Wrench with Quick Release like that shown in the Jones patent in suit has ever been commercially made and sold, even by the Petersen Co. The decisions of the Court below are in conflict with the following decisions of this Court and other Courts of Appeals:

Deering v. *Winona Harvester Works*, 155 US 286, 295; 39 L.Ed. 153 (1894)

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[8] *Julius Kayser & Co.* v. *Rosedale Knitting Co.*, 98 F.2d. 839 (CCA 3, 1938)
Himmel Brothers Co. v. *Sgrrick Corp.*, 122 F.2d. 740 (CCA 7, 1941)
Elliott Co. v. *Youngstown Car Mfg. Co.*, 181 F. 345 (CCA 2, 1910)
Detroit Gasket & Mfg. Co. v. *Victor Mfg. & Gasket Co.*, 114 F.2d. 868 at 872 (CCA 7, 1940).
Ruben Condenser Co. v. *Aerovox Corp.*, 77 F.2d. 266, 268 (CCA 2, 1935)
Audio Devices, Inc. v. *Armour Research Foundation*, 293 F.2d. 102 (CA 2, 1961)
Zoomer, Inc. v. *Poillard Products*, 258 F.2d 527, 529 (CA 2, 1958).

Roberts v. *General Electric Co.*, 25 F.2d. 964-6 (CCA 3, 1936)

Stewart-Warner Corp. v. *Jiffy Lubricator Co.*, 81 F.2d. 786, 793 (CCA 8, 1936).

Wire Tie Mach. Co. v. *Pacific Box Corp.*, 102 F.2d. 543, 556 (CCA 9, 1939)

Thompson v. *Westinghouse Elec. & Mfg. Co.*, 116 F.2d. 422, 425 (CCA 2, 1940)

Scott & Williams, Inc. v. *Whisnant*, 126 F.2d. 19 at 23 (CCA 4, 1942)

The Jones "paper" patent has been used entirely to compel tribute from independent inventors and manufacturers, who were offering their own forms of Toggle Wrenches with Quick Releases to the public. The parties to the Interference were prevented from manufacturing. H. R. Basford Co. of San Francisco, and Seymour Smith Company were compelled to take licenses and to pay royalty. Now Jones' "paper" patent is being used by the Petersen Company to suppress competition from Sears Roebuck. In September 1956 the Respondent Petersen Company bought its exclusive license and made it a condition of the license that the previous licenses to H. R. Basford Company and Seymour Smith Co. must be terminated, and that no other licenses could be granted (License, Par. 12, (Rp. 280-286). The role of Jones and the Petersen Company herein has been solely that of "speculative schemers" who "watch the advancing wave of improvement"—condemned by this Court in classic language in *Atlantic Works* v. *Brady*, 107 US 192 at 200, 27 L.Ed. 438 (1882).

6. The Courts below failed to give any weight to the fact that, while the Jones patent was pending in the Patent Office prior to July 4, 1950, at least 18 patent applications were filed showing alternative forms of Quick Release Mechanisms, most of them pivoted levers mounted on either

the Moyable Handle, the Toggle Link or the Fixed Handle, and camming against another member—Book of Patents Defts' Exh. G. These 18 applicants were independent inventors, because the Jones patent had not issued. Thereafter and up to May 1956, 13 more patent applications were filed and patents issued of similar nature. Again these 13 applicants were obviously independent inventors and not copiers, because the Jones Wrench was not commercially manufactured. But the unlimited scope which the Court of Appeals has given the Jones patent in suit as a "pioneer invention", described in functional terms in its paraphrase of the proper scope of claims 1, 4 and 5 as being completely unlimited as to the place the pivoted Release Lever is mounted and the part which it cams against to "break the toggle" (Opinion P. 28, Appendix A) makes it completely apparent that all of these 31 alternative structures can be regarded as infringing the Jones patent as "equivalents", because they also achieve the same result. *If the Court of Appeals' Opinion is allowed to stand by this Court, it will be impossible for anyone with safety to make a non-infringing Release Mechanism—and the monopoly of the Petersen Manufacturing Company in the field of Toggle Wrenches, which it enjoyed from 1924 to 1941 is thus extended to July 4, 1967; the date of expiration of the Jones patent in suit.*

7. The residence of the Respondent Jones in Colorado in the Tenth Circuit makes it impossible for any other manufacturer of a Toggle Wrench with Quick Release Mechanism to bring a Declaratory Judgment suit against the Jones patent in any other Circuit, to obtain a possibly conflicting decision on the scope of the Jones patent. This unlikelihood of obtaining a possibly conflicting decision on a patent was the ground for granting certiorari by this Court in *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 US 45 at 50 (1938). Certainly the respondents will not sue anywhere else, after these decisions of the Courts below.

8. The decisions of the Courts below herein in finding "inherent equivalency" of Parker's alternative structure not disclosed in the Jones patent is in direct conflict with the legislative mandate of R.S.4888 requiring full, clear, concise and exact written disclosure of the invention to the Patent Office, and distinctly claiming it. This statutory requirement cannot be circumvented by application of the doctrine of "equivalents" to cover alternative structures achieving the same result, not supported by the patentee's disclosure. The decisions of the Courts below are in conflict with the following decisions of this Court:

Keystone Bridge Co. v. *Phoenix Iron Co.*, 95 US 274 at 278 (1877)

Exhibit Supply Co. v. *Ace Patents Corp.*, 315 US 126 at 136-137, 86 L.Ed. 736 (1941)

Schriber-Schroth Co. v. *Cleveland Trust Co.*, 311 US 211 at 220-221 (1940)

Weber Electric Co. v. *E. H. Freeman Electric Co.*, 256 US 668 at 677-8 (1920)

9. The same application of the doctrine of equivalents by the Courts below to cover structures not disclosed in the Jones patent further renders the Jones patent invalid for indefiniteness, and for functional claiming and completely ignores the rights of the public to be apprised of the exact nature and limits of the invention and to rely on the claimed limits of the invention, as supported by the disclosure. The decisions of the Courts below are in conflict with the following decisions of this Court:

General Electric Co. v. *Wabash Appliance Co.*, 304 US 364 at 368-9; 82 L.Ed. 1402 (1937)

Merrill v. *Yeomans*, 94 US 568 at 573 (1876)

McClain v. *Ortmeyer*, 141 US 419 at 424 (1891)

United Carbon Co. v. Binney & Smith Co., 317 U.S. 228 at 236-237; 87 L.Ed. 232 (1942)
Halliburton Oil Well Cementing Co. v. Walker, 329 U.S. 1 at 12 (1946)
Holland Furniture Co. v. Perkins Glue Co., 277 U.S. 245 at 257 (1927)

10. The District Court and Court of Appeals in support of their finding of equivalency relied on the finding (No. 11, (Second) Rp. 19-20; Opinion, P. 30-31, Appendix A) that Jones during the pendency of his patent application, had constructed a model plier-type wrench having a release lever pivoted on the toggle link, as in the Parker, Seymour Smith (and Waterbury) wrenches. But, if true, there was then no excuse whatever for Jones to violate the Patent Statutes, particularly R.S.4888, which requires the applicant for a patent to make full, written disclosure of his invention to the Patent Office. The applicant Jones had a complete remedy for his failure to disclose this alternative structure originally—by filing a new application disclosing the structure, or a continuation-in-part application, (Patent Office Rule 70—Appendix B). He could not have included it in his pending application, because it would have been "new matter" (Patent Office Rule 70). And he could not have reissued his patent, because the alternative structure again would have been "new matter", and not "for the same invention"—R.S.4916.

But it is now apparent that Jones could not file such new application after the Seymour Smith Wrench had been on the market one year because he could not make the necessary oath (R.S.4886). But having a complete and proper remedy, there is no excuse whatever for the Courts below to ignore and circumvent the statutory requirements of R.S.4888 by invoking the doctrine of equivalents to recap-

ture the broad claim coverage otherwise forbidden to Jones by law.

11. The decisions of the Courts below, if not corrected by this Court, sanction a practice by resort to Equivalents which completely nullifies and circumvents the Patent Laws of the United States,—R.S.4888, R.S.4886 and R.S.4892 (now codified in the Patent Act of 1952, 35 U.S.C. Sec. 111 and 112, Sec. 102(b) and Sec. 115, respectively). This practice makes it impossible for any patent lawyer ever to advise a client that his proposed product does not infringe a patent,—as Justices Black and Douglas pointed out in their Dissenting Opinion in the *Graver Tank* Case.

Even worse, the practice sanctioned by the Courts below, in effect changes the Patent System of the United States, which since 1793 has required an inventor to make a written disclosure of his invention in "full, clear and exact terms",[9] and in similar language to date—into the German Patent System, where disclosure and language of claims are not binding on the German Patent Court in patent infringement suits.

12. When it becomes known to the Patent Bar that the Tenth Circuit ignores disclosures and the limitations in claims of patents, rewrites the claims of a patent in functional language to cover any possible mechanism embraced in such language which achieves the same result, and applies a doctrine of equivalents accordingly, even against independent inventors, the Tenth Circuit will quickly attract to itself all the patent litigation in the United States brought by patentees—making "forum shopping" more of a problem than ever before.

The decisions of the Courts below in this case are an instance of the gross mal-administration of the Patent Laws, which defeat their purpose to encourage independent

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[9] See the discussion by this Court of the earlier Statutes in *Miller* v. *Brass Co.*, 104 US 350 at 353-354 (1881).

invention. By the wholly improper application of the doctrine of equivalents they have granted a completely unwarranted expansion of Jones' patent monopoly, and have extended the effective monopoly on Toggle Wrenches with Quick Release Mechanisms to Respondent Petersen Mfg. Co. for another 26 years (from 1941 to 1967). Unless corrected by this Court, the decision of the Court of Appeals herein plunges the practice of patent law and litigation in the United States into hopeless chaos and confusion.

Conclusion

For the foregoing reasons, this Petition for a Writ of Certiorari should be granted.

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Appendix A

UNITED STATES COURT OF APPEALS
TENTH CIRCUIT
September Term - 1962

No. 6716

SEARS, ROEBUCK & Co., a New York corporation; and PARKER MANUFACTURING COMPANY, a Massachusetts corporation,
Appellants,
v.
HAROLD T. JONES and THE PETERSEN MANUFACTURING COMPANY, INC., a Nebraska corporation,
Appellees.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF COLORADO

Before MURRAH, Chief Judge; and BREITENSTEIN and HILL, Circuit Judges.

MURRAH, Chief Judge.

This is an appeal from a judgement holding appellee's patent for "Locking Wrench and Pliers" valid and infringed and enjoining the future sale of appellants' accused device. Jones is the owner of the patent in suit, and Petersen Manufacturing Company, Inc. is his exclusive licencee. Sears, Roebuck & Co. markets the accused device, manufactured by Parker Manufacturing Company.

Appellants first assert noninfringement, then invalidity. But, we follow what has been said to be the better practice, and first consider the issue of the validity of the patent. *Sinclair & Carroll Co., Inc.* v. *Interchemical Corp.*, 325 U.S.

327; and see: *Blish, Mize And Silliman Hardware Co.* v. *Time Saver Tools, Inc.* (10 CA), 236 F. 2d 913.

The patent in suit (Jones' #2, 514, 130) relates to a plier-type toggle wrench[1] having a quick and easily operated release lever positioned between the handles of the wrench and adopted to pry the wrench open. The release mechanism, which constitutes the improvement embodied in the patent, is described in Jones' specifications as comprising a lever pivotally mounted on the movable handle, within the channel formed by the sides of such handle, the forward end or toe of which, when the lever is moved toward the fixed handle, comes against the lug on the bifurcated toggle link and thus moves the center pivot point across the "dead center line". Jones also describes a heel portion on his lever, so that when the release lever is moved away from the fixed handle it rocks on its heel and the toe portion comes against the lug on the toggle link, again causing the center pivot point to cross the "dead center line", thus breaking the toggle. Hence, as specifically described and exemplified in its preferred form in the specifications, Jones' lever pivots on the movable handle and cams against the toggle link to break the toggle and open the jaws of the wrench.

The trial court found, and the evidence confirms, that Jones was the first in the art to disclose a release lever of any kind between the handles of a plier-type toggle wrench which cooperated with the movable handle and toggle link to pry open the jaws of the wrench. And an examination

[1] The operating principle of the "toggle" wrench, in connection with the usual plier-type wrench action of jaws of a fixed handle and a movable handle, utilizes a toggle joint comprised of the pivoted movable handle and a toggle link pivotally engaged at its lower end to the movable handle and constituting a "central pivot point". When this central pivot point to the toggle joint crosses the "dead center position" the toggle joint imposes a locking action on the movable jaw of the wrench to hold the work piece in a vice-like grip.

of the prior art discloses no patents previous to Jones' first filing date teaching the Jones method of release, i.e., the cooperation of a lever with the handle and toggle link to pry open the jaws of a toggle wrench. In this regard, the trial court found that the Jones patent disclosed a pioneer invention and that its claims were entitled to an interpretation with a full range of equivalency. The court noted, however, that even if the invention be not pioneer, it is at least entitled to the doctrine of equivalents to some substantial extent, by reasons of its important contribution to the art.[2] And we are convinced from an examination of the findings of the trial court and their record support that the patent in suit is neither void by reason of anticipation by prior art or by obviousness.

In typically esoteric phraseology, the claims of the patent held to be infringed (Claims 1, 4 and 5) describe, in essence, the following improvements:

Claim 1: A release lever privotally attached to the movable handle which came against the toggle link in its closed position to open the toggle—thus opening the jaws of the wrench.

Claim 4: A release lever pivotally attached to the movable handle which cam against either the toggle link or the fixed handle to open the wrench.

Claim 5: A release lever pivotally attached to either the movable handle, the fixed handle, or the toggle link and which, by camming means, opens the jaws of the wrench when rocked about its pivot.

It is conceded that Claims 1 and 4 do not read directly upon appellants' accused device, which adapts to a toggle

[2] Without a release lever, the forcible use of both hands by the operator of a toggle wrench is necessary to effect its disengagement from the work piece—a requirement proving to be difficult as well as productive of "skinned knuckles" under various circumstances, especially when the wrench is used in restricted places.

wrench a release lever pivotally attached to the toggle link and which, by camming action against the movable handle, breaks the "toggle" and opens the wrench. The trial court found, however, that the application of the release lever utilized by the accused device employed a mere reversal of the parts demonstrated in the patent in suit. Indeed, as the trial court observed, the only substantial distinction is that in one the lever pivots on the movable handle and cams against the toggle link and in the other it pivots on the toggle link and cams against the movable handle. We agree with the finding of the trial court, supporting his conclusion of infringement as to Claims 1 and 4, that "defendants' device produces the same result in substantially the same way and by substantially the same means . . ." as that described in the patent in suit. See: *Johns-Manville Corp.* v. *National Tank Seal Co.* (10 CA) 49 F.2d 142, 146; and *Sanitary Refrigerator Co.* v. *Winters*, et al, 280 F.S. 30, 42.

Appellants contend, however, that the form of release employed by their wrench was not precisely disclosed by the Jones specifications and that the equivalency afforded the Jones invention by the trial court served to void that patent for indefiniteness. Jones' specifications, however, clearly demonstrates the release lever positioned between the handles, pivotally attached to the movable handle so as to cam against the toggle link. There is nothing indefinite about this disclosure which sets forth, by word and picture, the same operative parts and inventive method which was reversed, with inconsequential variations in structure, by appellants.

Relatedly, we reject appellants' argument that the trial court erred in extending to the patent in suit too wide a range of equivalency. The obvious reversal of parts employed by the accused device is neccessarily included within the minimal equivalency to which even a patent granted on a small advance over a prior crowded art is entitled. See:

Skinner Bros. Belting Co. v. *Oil Well Improvements Co.* (10 CA) 54 F. 2d 896.

Claim 5, which reads directly on the accused device, is said by appellants to be void for two reasons; One—It is not supported by the disclosure of Jones' patent. Two—It was first filed more than one year after the public sale and use of a wrench utilizing the design and operation which it sets forth.

35 U.S.C. §112 provides that" . . . the specification shall contain a written description of the invention, and of the manner and process of making and using it. . . ." But this does not require a description of all of the variations which might suggest themselves to one versed in the art. And in light of our approval of the trial court's finding of a reversal of parts, appellants' contention relative to inadequate disclosure by Jones dissolves into the untenable complaint that Jones did not specifically describe the reversed applications of his invention.

Appellants' assertion concerning the previous public sale and use of a wrench encompassed within the specific language of Claim 5 requires additional consideration. 35 U.S.C. §102(b) provides, in essence, that a person shall not be entitled to a patent if his invention has been in public use or sale for more than one year prior to the application. And it is conceded by appellees that a wrench, having properties like those of the accused device and which are directly covered by Claim 5, was commercially marketed by one Seymore Smith more than one year prior to the filing of that claim. But, the trial court found, and the proof confirms, that Jones had, during the pendency of his original patent application, constructed a model plier-type wrench having a release lever pivoted on the toggle link, as in the cases of the accused device and the wrench later marketed by Smith. This model wrench was shown by Jones to his patent attorneys, who advised him that the structure em-

bodied in the model was included and protected within the range of equivalency attaching to the original patent disclosure. And in light of the trial court's findings that the variation contained in the accused device (and in the Smith wrench) was but an infringing reversal of parts, the advice thus given was sound. Indeed, the variations recited in Claim 5 are but explicit statements of what is necessarily implicit in the original disclosure of Jones' patent. For this reason the principles concerning prior public use espoused in *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 305 U.S. 47, and *Muncie Gear Works, Inc.* v. *Outboard Marine & Mfg. Co.*, 315 U.S. 759 are here inapplicable. Those principles have as their purpose the protection of rights intervening prior to some "new invention" stated in a later claim. Here, the Smith wrench was within the clear range of equivalency, hence anticipated by the disclosures of Jones patent application, filed long prior to the use and sale of that wrench. No "intervening rights", such as would render Claim 5 invalid could therefore exist.

Lastly, appellants assert the "Doctrine of File Wrapper Estoppel", i.e., that in the prosecution of his patent within the Patent Office, Jones cancelled certain rejected claims, accepted narrower claims in their stead, and is now estopped from obtaining a breadth of construction as broad as that contained in the claim voluntarily cancelled. We have recognized and applied this doctrine on several occasions. See, e.g.: *Jensen-Salsbery Laboratories, Inc.* v. *Franklin Blackleg Serum Co.* (10 CA), 72 2d 13; *Ratigan* v. *Dickard Supply Co.* (10 CA), 91 F.2d 722; *Texas Co.* v. *Anderson-Pritchard Refining Corp.* (10 CA), 122 F.2d 829; *Jones* v. *Broadpass* (10 CA), 189 F.2d 838; *U.S. Air Conditioning Corp.* v. *Governair Corp.* (10 CA), 216 F.2d 430; and *Doran Coffee Roasting Co.* v. *Wyatt Mfg. Co.* (10 CA), 267 F.2d 200. In these cases, however, the patentee limited his claim to a specific structural detail in view of the disclosures of

prior art; argued and represented that the structural detail defined in his claim constituted the distinguishing feature of his patent over prior art; and issued his patent only with claims limited to such structural detail, thus acquiescing in the Patent Office rejections based on prior art disclosures. Jones' difficulty with the Patent Office did not result from any prior art similarities which had to be resolved by the limitation of his inventive claims to structural differences. Rather, Jones' attorneys had difficulty in wording claims acceptable to the Patent Office and the rejection of claims was based on "indefiniteness". The claims in suit solved Jones' problem of "indefiniteness" and since Jones did not, by representation or acquiesence, limit his patent to the specific structure of a release lever pivoted on the movable handle, we find no estoppel.

Affirmed.

Appendix B

Sec. 4888 R.S. (U.S.C., title 35, sec. 33) Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art of science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.

Sec. 4886. R.S. (U.S.C., title 35, sec. 31) Any person who has invented or discovered any *new* and useful art, machine, manufacture, or composition of matter, or any *new* and useful improvements thereof . . . . . not known or used by others in this country, before his invention or discovery thereof . . . . . and not in public use or on sale in this country for more than one year prior to this application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent thereof.

Sec. 4892. R.S. (U.S.C., title 35, sec. 35) The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement, or of the variety of plant, for which he solicits a patent; that

he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen.

Patent Office Rule 70 (in effect 1941 through 1950):

70. In original applications all amendments of the drawings or specifications, and all additions thereto, must conform to at least one of them as it was at the time of the filing of the application. *Matter not found in either, involving a departure from the original invention, can not be added to the application* even though supported by a supplemental oath, *and can be shown or claimed only in a separate application.*

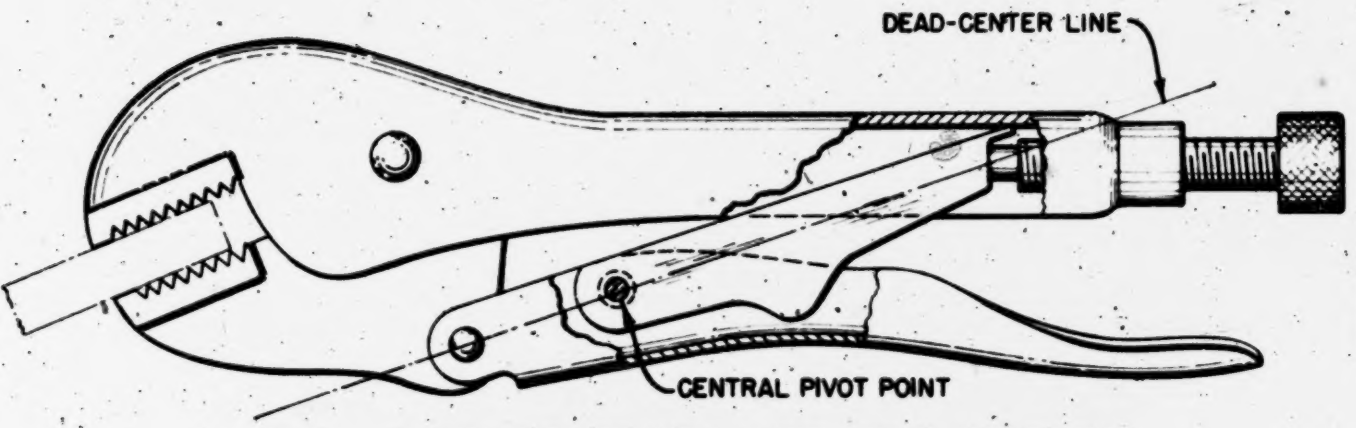


FIG. 1. BASIC PETERSEN VISE-GRIP WRENCH
Petersen patent No. 1,489,458
Issued April 8, 1924
Expired April 8, 1941

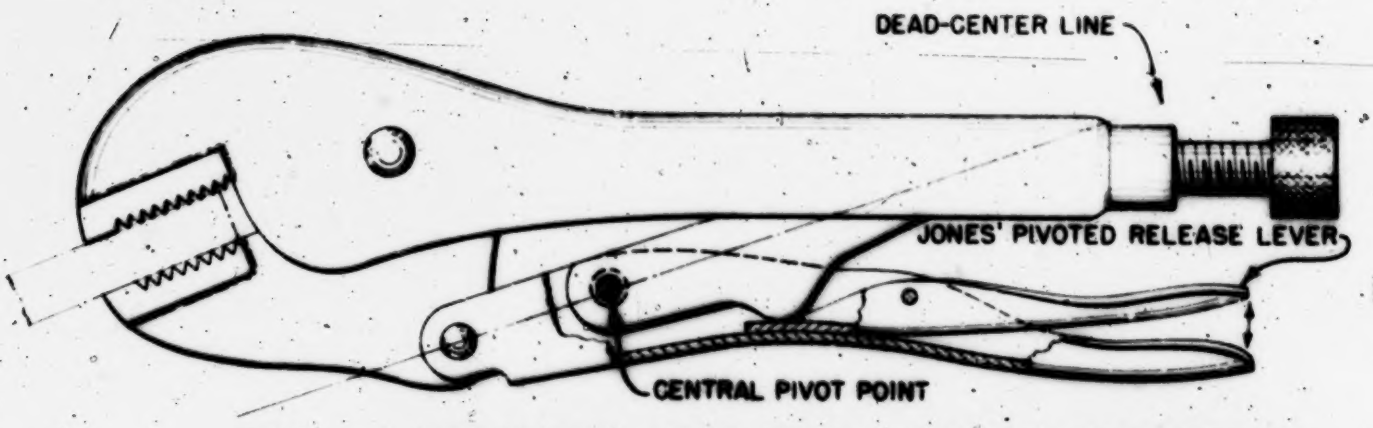
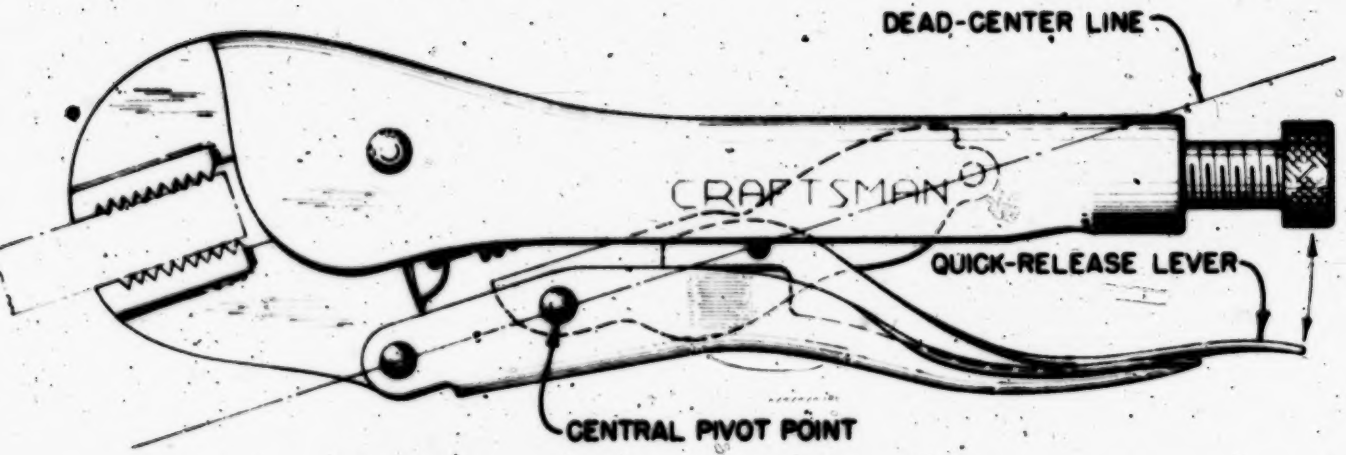


FIG. 2. PETERSEN VISE-GRIP WRENCH EMBODYING QUICK-RELEASE LEVER OF JONES PATENT IN SUIT NO. 2,514,130.



PARKER TOGGLE WRENCH WITH QUICK-RELEASE LEVER

July 4, 1950 H. T. JONES 2,514,130

LOCKING WRENCH AND PLIERS

Filed June 20, 1944

Fig. 1.

Fig. 3.

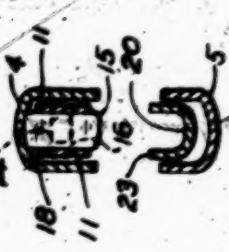


Fig. 2.

INVENTOR
HAROLD T. JONES
BY J. W. Brinkley

ATTORNEY

Patented July 4, 1950 2,514,130

UNITED STATES PATENT OFFICE

2,514,130

LOCKING WRENCH AND PLIERS

Harold T. Jones, Vallejo, Calif.

Application June 20, 1944, Serial No. 541,222

5 Claims. (Cl. 81—94)

1

This invention relates to wrenches or pliers of the type having besides a pair of plier-like handles, a toggle lever brought into action when gripping a nut or other object so as to greatly multiply the pressure of the gripping jaws.

The principal object of the present invention is to provide improvements over the construction of such a wrench shown in U. S. Patent No. 2,280,005 whereby the toggle lever action is improved.

Specific features of the improvement will appear in the following description and accompanying drawings.

In the drawings Fig. 1 is a side view of the wrench with the forward sides of the channel shaped handles broken away to reveal the toggle lever action positioned between them.

Fig. 2 is a cross section of Fig. 1 taken along the line 2—2 of Fig. 1.

Fig. 3 is a detached perspective view of the toggle pivot block.

The general construction of the tool follows the showing of the U. S. patent above mentioned in that it comprises preferably a pair of pipe

2

in the inner end of the screw 13 and revolvably fitting therein a pin 14 having an enlarged head or block 15 at its end against which the end of the screw bears. This head is of a size and form to fit within the channel of the handle so as to be slidable therealong and in contact with the underside of the channel as at 18 as the screw is turned.

The head 15 of the pin 14 is flattened at opposite sides and is transversely pivoted to the end of the lever as by a pin 16, the end of the lever being shown bifurcated at 17 to straddle opposite flat sides of the head 15, or the head may be bifurcated and the end of the lever solid if desired.

The toggle lever 11 is provided with a foot 19 at an intermediate point in its length which is directed into the channel of the lower handle 5 to rest upon a releasing lever 25 which is preferably of sheet metal of generally U-shaped cross section to easily fit within the handle and is kept in place by a transversely extending pin 21 secured to the side walls of handle 5 and working freely in a slot 22 in the side walls 23 of the

wrench-like jaws 1 and 2 transversely pivoted together at 3 and with one of the plier-like handles 4 extending rigidly from jaw 1, while the other handle 5 is transversely pivoted at its inner end as at 6 to a rearward extension 7 of the other jaw 2.

Both handles are preferably of more or less hollow channel or U-shape in cross section arranged in confronting relation as indicated, and a coiled tension spring 8 hooked at one end as at 9 through an opening near the center of the fixed handle and at its other or forward end to a small apertured lug 10 on jaw 2 tends to resiliently pull the jaws open.

Within the confronting hollow handles is a lever 11 cooperating with handle 5 to form a pair of toggle levers. Lever 11 normally extends at an angle between the handles with its opposite ends positioned respectively within the channels of the two handles and with its forward end transversely pivoted as at 12 to handle 5 and its opposite or outer end transversely pivoted to the inner end of an adjusting screw 13 longitudinally screwed into the outer end of handle 4 which is made tubular for a distance adjacent the end and threaded to receive the screw as indicated, but except for this tubular threaded portion 4' the handle 4 is a freely open channel on its under side as indicated in the drawings.

The pivotal connection of toggle lever 11 to the screw comprises drilling a hole longitudinally releasing lever. The lever extends forward of this pin a relatively short distance so that its forward end 24 pivots or fulcrums against the handle 5 when the outer or rearward end 25 of the releasing lever is lifted or pulled toward handle 4, the releasing lever being extended rearwardly beyond the handle 5 to make it accessible to a finger of the hand holding the plier-like handles when engaging a nut or other object X between the jaws 1 and 2 so that the grip may be instantly released at any time upon pulling the releasing lever.

The extreme rearward or outer end of handle 5 is bent somewhat abruptly away from handle 4 as at 5' and the overlying end of lever 20 is similarly bent or formed while providing clearance 26 below the lever so that it may preferably also be rocked downward as well as upward. The fulcrum or pivotal support for such downward rocking of lever 20 may be a slight shoulder or heel in the channel of lever 20 as at 27 where the clearance 26 begins.

By the construction described the screw 13 may be longitudinally moved by turning its head 13' to adjust the jaws of the tool for thickness of the object to be gripped, and when the jaws are closed upon the object by pressing the plier-like handles towards one another the toggle lever 11 will straighten out through a line drawn through the centers of pins 8, 12 and 18 to thereby develop an enormous pressure on the grip.

The length of the foot 19 of the toggle lever is such as to permit the center of pin 12 to just pass the center line 28 so as to lock the grip upon the object when desired to thereby avoid the otherwise necessity of applying maximum hand pressure on the handles all the time. When the job being worked on is finished the locked toggle grip may be easily released by either pressing downward or pulling upward on the outer end 26 of releasing lever 20 which upon being rocked either way will forcibly move handle 8 slightly outward from foot 19 to carry the center of pin 12 back over the center line 28, so that the toggle will collapse under the effect of spring 9 as well as from the pressure of the work tending to spread the jaws, and the wrench will at once open to the dotted line position.

It is of course obvious that heel 27 on releasing lever 20 may be omitted if it is desired to have the releasing lever operate by pulling its outer end up only.

Having thus described my improved construction in the toggle wrench of this kind, what I claim is:

1. In a wrench comprising the combination of a handle provided with a stationary jaw, a movable jaw mounted on said handle, a toggle comprising a channel shaped handle lever pivotally engaged at one end with said movable jaw and a toggle link pivotally engaged at one end in the channel of said handle lever intermediate its ends and at its other end with said handle, the improvement which comprises a toggle release lever pivotally secured within the channel and extending longitudinally therein, the free end of said release lever extending beyond the

mediate the ends thereof, the operating lever extending longitudinally adjacent the first member in spaced relation thereto and arranged to be squeezed by a hand engaging the wrench to lock the toggle, the improvement which comprises; an elongated toggle release lever having a portion positioned between said first member and said operating lever and extending longitudinally and rearwardly in the space therebetween and having its forward end disposed within the channel of said operating lever and operatively connected thereto by pivot means, mounted for movement in a plane passing through the first member and said operating lever, the release lever having a portion projecting rearwardly beyond the rear end of said second member adapted to be engaged by a finger of the hand, the release lever having a camming portion engageable with one of said members when it is actuated.

5. In a wrench comprising the combination of a handle provided with a stationary jaw at the forward end thereof, a movable jaw mounted on said handle, a toggle comprising an elongated channel shaped handle lever pivotally engaged at the forward end thereof to said movable jaw and a toggle link pivotally engaged at one end in the channel of said handle lever intermediate its ends and at its other end with said handle, for locking the wrench in gripping an article, the improvement which comprises; an elongated toggle release lever having a portion extending longitudinally and rearwardly in the space between the channel shaped handle lever and the toggle link, pivotally connected with one and

end of said release lever extending beyond the corresponding end of the handle lever and a portion of said release lever being engageable with said toggle link in the closed position of said handle lever to release said toggle.

2. In a wrench as set out in claim 1 the pivotal securing of said release lever being loose to permit the two way rocking of said release lever for release of the toggle upon either way of movement of said lever.

3. In a wrench as set out in claim 1 said toggle link provided with a foot in contact with the inner portion of the toggle release lever.

4. In a wrench of the type having a first member formed as an elongated handle provided with a stationary jaw at the forward end thereof, a movable jaw mounted on said member arranged to cooperate with the stationary jaw to grip an article, a toggle for operating the movable jaw comprising a channel shaped operating lever pivotally engaged at the forward end thereof to the movable jaw, and a second member formed as a toggle link pivotally engaged at its ends to the first member and said operating lever intermediate its ends, said operating lever being provided with cam means engaging the outer when it is rocked about its pivot, said toggle release lever having another portion projecting rearwardly beyond the rear end of the handle lever disposed in position to be engaged by a finger of the hand holding the wrench.

HAROLD T. JONES.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1962

No. 596

SEARS, ROEBUCK & Co. and PARKER MANUFACTURING COMPANY, *Petitioners,*

v.

HAROLD T. JONES and THE PETERSEN MANUFACTURING COMPANY, INC., *Respondents.*

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT

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IN THE

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RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT

OPINIONS BELOW

The opinions of the Courts below holding the patent in suit valid and infringed are reported as follows:

District Court—187 F. Supp. 293; 127 USPQ 411;
Court of Appeals—308 F(2d) 705; 135 USPQ 149.

NO QUESTION PRESENTED

There is no question presented since the following facts were clearly established by the evidence:

(a) That the invention of the patent represents "an important contribution to the art;"

(b) That the prior art fails to disclose anything previous to the inventor's application filing date teaching the inventor's method of operation and type of structure;

(c) That the accused infringing structure incorporates a mere reversal of parts from the structure shown as the illustrative preferred embodiment of the patent in suit, which reversal is obvious to even a layman;

(d) That the inventor of the patent in suit was, before the filing date of the application for the patent in suit, the first to make both the structure shown as the illustrative preferred embodiment in the patent in suit and the alternative structure with reversed parts;

(e) That the inventor of the patent in suit, and his attorneys, from the outset, were constantly seeking claims unequivocally reading on the structure of the invention with or without the parts reversed, but as to such claims repeatedly met with Patent Office Examiner's objections as to the phraseology until after Interference and Appeal Proceedings were terminated, whereupon the patent was issued with all the claims in suit;

(f) That the accused structure admittedly falls literally within the express terms of one claim of the patent in suit and implicitly within other claims;

(g) That the patent was only issued after an Interference Proceeding and after an Appeal Proceeding in the Patent Office.

(h) That the patentee never argued or represented to the Patent Office that his invention was limited to the specific structural arrangement shown in the patent drawing as the illustrative embodiment of the invention, but instead continuously argued for, and ultimately obtained an allowable claim unequivocally reading on the invention with or without the parts reversed, thus precluding any estoppel.

(i) Even though Petitioners had four different models of releasing plier-type toggle wrenches available at the time of their initial production, they intentionally produced and sold the accused infringing wrench (1) after studying Respondents' commercial wrench; (2) with knowledge that the accused infringing wrench was the closest model to Respondents' commercial wrench made in accordance with the preferred embodiment of the patent in suit; and (3) after reviewing their own attorney's opinion indicating that the other three models available did not even present a question of infringement of the patent in suit.

STATEMENT OF THE CASE

Petitioners' "Statement of the Case" is inaccurate and incomplete in many respects. Respondents, for completeness and in answer to Petitioners' misstatements of facts, present in Appendix A hereto and accurate Statement of the Case. Incorporation of a Statement of the Case in the body of this Brief appears unnecessary in view of the following reasons, which clearly demonstrate the lack of any basis which would justify this Court's review of the instant case.

REASONS FOR DENYING WRIT OF CERTIORARI

I. PETITION MANIFESTS ITS OWN WEAKNESS—LARGE NUMBER OF ALLEGED ERRORS AND CITED DECISIONS DEMONSTRATE LACK OF ANY ISSUE JUSTIFYING REVIEW ON CERTIORARI

The Petition speaks in terms of generalities, lists eight supposedly novel questions presented, alleges at least ten errors supposedly made in the consistent Decisions of both Courts below, and cites over thirty prior cases supposedly in conflict with such decisions.

If Petitioners were in possession of even one valid error or true instance of inconsistency, then their Petition would have been specific, and would not have alleged a multiplicity of different errors reading like the index of a patent law text book, and phrased in terms of inapposite "words of art" calculated to catch the eye of the reader.

As this court apparently recognizes by its acceptance of patent cases only in the rarest instances, the patent laws are notoriously well defined, having remained basically the same for over a century. Accordingly, it is unreasonable to believe that there are actually eight novel questions of law presented by the instant case.

There are, in fact, **no novel questions of law presented**, and the Petitioners' listing of a multiplicity of questions alone indicates the weakness of the Petition.

Furthermore, the Court of Appeals for the Tenth Circuit has often been called upon in recent years to review patent cases, and Chief Judge Murrah, the Judge delivering the opinion below in the present case, has personally delivered a substantial number of the recent patent opinions from his Court. It is thus apparent that the present case has been viewed by experienced eyes—eyes which cannot reasonably be presumed to have committed ten errors of law which result in a decision conflicting with over thirty prior cases,* as Petitioners assert.

Viewed in proper perspective, the Petition is but a request for a trial *de novo*—it demonstrates that there is no justification for review of the present case.

II. THE ISSUES PRESENTED IN THE INSTANT CASE ARE USUAL FACTUAL ISSUES CONCERNING THE VALIDITY AND INFRINGEMENT OF A PATENT—ISSUES DECIDED WITH CONSISTENCY BY BOTH THE DISTRICT COURT AND THE COURT OF APPEALS

The basic questions presented in this case are the usual factual-type questions which arise in patent litigation. When such issues are extracted in intelligible form from the Petitioners' Brief, they can be accurately summarized as follows: (a) Was the patentee the first in the art to disclose a release lever of any kind between the handles of a plier-type toggle wrench which cooperated with the movable handle and toggle link to pry open the jaws of the wrench? (b) Was

* Substantially all of such cases were cited and/or quoted in the Courts below by Petitioners.

there any problem which was solved by the invention and which evaded prior solution? (c) Does the accused structure produce the same result, in the same way, by at least substantially the same mechanical means as the structure shown as the illustrative preferred embodiment of the patent in suit even within a minimal range of mechanical equivalents? (d) Is there anything indefinite about the disclosure of the patent which sets forth as the preferred embodiment, by word and picture, the same operative parts and inventive method which was reversed, with inconsequential variations in structure, by the infringers? (e) Is the wording of Claim 5 of the patent, which admittedly reads directly on the accused structure, anything more than a rephrasing of claims continuously sought in the application from the filing date thereof, or an explicit statement of what was implicit in the original disclosure of the application for the patent in the suit? (f) Did the patentee limit his claims to a specific structural detail in view of the disclosures of prior art, argue or represent that such detail defined in his claim constituted the distinguishing feature of his claims over prior art, and then issue his patent only with claims limited to such structural detail?

Each of the above **ordinary patent litigation questions** are clearly factual. They have each been resolved, after careful consideration, in favor of the Respondents, by both the United States District Court for the District of Colorado and by the United States Court of Appeals for the Tenth Circuit. Under these circumstances, this Writ should be denied in accordance with at least the following cases: *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U.S. 405, 416; *Williams Manufacturing Co.* v. *United Shoe*

Machinery Corp., 316 U.S. 364, 367; *Goodyear Tire & Rubber Company, Inc.* v. *Ray-O-Vac Company*, 321 U.S. 275, 278.

III. THERE ARE NO UNUSUAL QUESTIONS OF WIDESPREAD INTEREST

(A) The Patent Concerns a Specific and Particular Type of Wrench, and Is NOT of "Unusual" Public Importance

The patent in suit concerns a specific type of release for a plier-locking wrench—one of many types of locking wrenches—locking wrenches being one species within the broad class of wrenches in general—wrenches in general being one category of hand-gripping tools—hand-gripping tools being one classification under the broad heading of hand tools—and hand tools being a category of tools generally. Thus, it is obvious that the subject matter of the patent only has application to a minor fractional part of one very narrow branch of a specific industry. Accordingly, no stretch of semantics can make the patent of sufficient public importance to justify review of the decisions below by this Court.

(B) There Is No Question of Expansion of the Patent Monopoly—Petitioners Purloin Words of Art in Attempt to Catch Eye of Court

Petitioners, after listing no less than eight lengthy and somewhat repetitive "Questions Presented" finally conclude with a short, so-called "basic question" which exceeds even the most imaginative concepts that may be remotely applicable to the present case. Their extraction and use of certain words of art within the so-called "basic question", namely, "undue expansion of the patent monopoly" represents an attempt to attach some significant legal aspect to the present case, which

is not only contrary to fact, but is also manifestly contrary to Petitioners' own admissions.

Petitioners admit that one claim of the patent in suit at least, namely, Claim 5, reads directly and unequivocally on the accused infringing wrench. Accordingly, infringement was found within the express words of the patent claims without any expansion whatsoever. The doctrine of equivalents was used only to show that there was clear infringement of even the most specifically worded claims of the patent in suit, if such claims were given the narrowest interpretation. Infringement of the more specifically worded claims was within the express terms of Claim 5, and thus there obviously was no expansion of the patent under the doctrine of equivalents. Moreover, since one claim of the patent expressly covers the accused infringing structure, the present case is within the narrowest bounds of *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 339 U.S. 605, even consistent with the dissenting opinions thereof. Still further, there is no issue of "patent misuse" in the present case, and thus the circumstances in which the phrase "undue expansion of the patent monopoly" finds its customary application, are not existent here.

Through use of the word "expansion", the Petitioners attempt to generate interest in an ordinary patent infringement action which, in fact, as indicated above, is free of any "expansion" issue (as well as any other unique or generally important issue).

(C) Nothing Was Sacrificed So There Is Nothing That Could Have Been Recaptured

As the Courts below verified, the accused infringing structure was an infringement of at least one of the earliest presented and earliest allowed Claims (Claim 1) in the Jones' application. It is thus clear that no protection was sacrificed, so there was nothing which could have been recaptured as Petitioners assert. While Claims worded similar to Claim 5 of the patent met with early rejections on indefiniteness, Claim 5 was ultimately allowed. As allowed, the Claim represented but a rephrasing of prior claims and an express statement of protection which was otherwise implicit.

(D) There Can Be No Expansion of a Petersen Monopoly—the Only Monopoly Involved Is That Given Jones By His Patent

The Jones' patent, consistent with the Constitution and Patent Laws formulated thereunder, gave Respondent Jones the privilege to exclude others from use of his invention—a privilege which Jones could use or license as Jones saw fit. Jones licensed **his** privilege to Respondent Petersen in return for a royalty when Jones' prior licensees were in default. Respondent Petersen did no more than compensate the inventor Jones (a separate and distinct individual from Petersen in every way) in return for certain rights under the patent laws which were given Jones to use or license, as Jones desired.

IV. THERE IS NO INCONSISTENCY BETWEEN THE DECISIONS BELOW AND ESTABLISHED PRINCIPLES OF PATENT LAW, DECISIONS OF THIS COURT, OR DECISIONS OF OTHER COURTS—MISCELLANEOUS ARGUMENTS FAIL

(A) There Is No Question of "Pioneer Invention"—Both Lower Courts Considered Minimal Equivalency

The Doctrine of Equivalents was used by the Courts below to show clear infringement of even the most specifically worded claims of the patent suit, which infringement was within the express terms of at least one other claim of the patent in suit. Notwithstanding this fact the Trial Court, looking further than necessary, believed that the facts established that the invention shown in the patent was a pioneer invention. However, the Trial Court recognized that this was a close determination, and based its consideration of the limited issue involving equivalents expressly on the assumption that the invention was not of pioneer character. The Court of Appeals similarly based its decision on the limited issue on a very conservative approach stating:

> "Relatedly, we reject appellants' argument that the trial court erred in extending to the patent in suit too wide a range of equivalency. The obvious reversal of parts employed by the accused device is necessarily included within the minimal equivalency to which even a patent granted on a small advance over a prior crowded art is entitled."

It is thus apparent that the Petitioners' arguments with respect to "pioneer invention" as applied herein represent use of a particular phrase taken completely out of context. The test of equivalency applied in the courts below is clearly consistent with the well established and well defined case law. *Sanitary Refrig-*

erator Company v. *Winters et al*, 280 U.S. 30, 40-43; *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, *supra*, 414-422; *Imhaeuser* v. *Buerk*, 101 U.S. 647, 662-664; *Machine Company* v. *Murphy*, 97 U.S. 120, 125; *Ives* v. *Hamilton, Executor*, 92 U.S. 426, 430-431. Moreover, as explained above, equivalency was not used to expand the patent.

(B) The Inability of Petitioners' Attorney to Properly Advise His Clients Results From His Own Conduct Rather Than Misapplication of the Law by the Courts Below

The opinion given by Petitioners' attorney prior to the present litigation, is used as a basis for arguing that the Decisions below are contrary to established law. Such opinion states that Claim 5 of the patent does not read on the accused infringing structure; at the same time, Petitioners **now admit** that Claim 5 does expressly and unequivocally read on the same accused infringing structure. In brief, the opinion given on one day's consideration and without reviewing the file of the patent in suit, contains an obvious and admitted error.* Under these circumstances, the argument that counsel could not properly advise his clients in view of the Decisions below, must obviously fail. Even before the Decisions below, counsel for Petitioners did not properly advise his clients.

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* The points of law which Petitioners argued below and repetitiously argue here, concern matters about which Petitioners' attorney was completely ignorant at the time the opinion in question was given and therefore could not have affected his opinion. Each point relates to facts developed after the litigation was instituted and after Petitioners' attorney realized that his initial opinion was clearly in error.

(C) The Decisions Below Are Clearly Consistent With Many Cases of This Court Involving the Same Type of Fact Situation

The Decisions of this Court in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605; *Hildreth v. Mastoras*, 257 U.S. 27; *Sanitary Refrigerator Co.* v. *Winters, supra; Smith* v. *Snow*, 294 U.S. 1, and, *Winans* v. *Denmead*, 56 U.S. 329, alone serve to demonstrate the consistency between the established law and the decision reached in the present case. These prior decisions involve fact situations which were substantially less favorable to the patentee than the instant decision. The instant case thus falls within the most limited interpretation of these prior cases. Other decisions of this Court, too numerous to mention in detail, further demonstrate the fact that this case is just another patent case to which the usual legal principles have been properly applied.

(D) The Decisions Below Are Clearly Consistent With Decisions of Other Circuits Involving Substantially Identical Fact Situations

The Second Circuit Court of Appeals and the Seventh Circuit Court of Appeals have been presented with fact situations which are essentially identical with that presented in the instant case. Both Circuits have resolved the cases consistent with the Decisions in the present case. See, Judge Learned Hand's decision in *Engineering Development Laboratories* v. *Radio Corporation of America*, 153 F. (2d) 523, (CA 2, 1946). Also see, *Binks Mfg. Co.* v. *Ransberg Electro-Coating Corp.*, 281 F. (2d) 252 (CA 7, 1960)

CONCLUSION

For the foregoing reasons, Respondents pray that the Petition for a Writ of Certiorari be denied.

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APPENDIX A

STATEMENT OF THE CASE

The following statement of the case, consistent with the facts found in the District Court and affirmed by the Court of Appeals, is presented herein because Petitioners' "Statement of the Case" speculates in the bald reassertion of "Ivied-covered" arguments without regard to facts.

(A) Contribution to Art—Prior Unsatisfactory "Release"

The patent in suit relates to plier-type toggle wrenches. Such wrenches effect a tight vise-like grasp of an article and are commonly used by mechanics working in restricted spaces, such as under the hood of an automobile.[1] Without a release lever thereon, such as that invented by Respondent-patentee Jones, both hands are required to open the wrench, often resulting in "cracked knuckles."[2] The Jones release lever invention eliminated this problem. The Petitioner, Sears, Roebuck, prior to appropriating the Jones invention to its use, sold a wrench having a so-called "quick release" thereon. Such early structure was different from the structure now used in the accused infringing wrench, and Petitioner Sears admits that such early structure (now abandoned) was inoperative to effect a quick release.[3]

(B) Inventor Makes Two Models—One With Reversed Parts of Other. Attorney Advises Both Models Covered By Application as Filed

After Jones developed his first model of the wrench with the release lever, he took the same to his Patent Attorney

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[1] See Petersen Pat. 1489458, Def. Exh. F, R. pp. 500, 639.

[2] R. pp. 502-503, 524, 541, 567.

[3] R. p. 415, "Well, I knew that it didn't work properly and that it was hard to operate and that when we called it an easy action it was a misnomer because it wasn't . . . It operated horribly hard."

and a Patent Application was filed on the invention.[4] The details of this model were used as a basis for the illustrative embodiment of the invention presented in the drawing of the application. Shortly after the application was filed, Jones brought a second wrench to his attorney showing the release lever parts reversed from the illustrative embodiment. The second wrench had been constructed before the application was filed and operated in an identical manner to the original model.[5] Jones was then advised by his attorney that the claims of the originl Patent Application covered the basic invention, with or without the parts reversed, and that there was no need to file another application.[6]

(C) Usual Prosecution of Patent Application—Claims Sought From Filing Date Approved in Appeal Proceeding Following Priority Contest

The Jones application was prosecuted in the Patent Office in a conventional manner, and claims were cancelled, added, and amended in response to Patent Office Actions. The Patent Office rejected the Jones' claims on the basis that the claims were indefinite or functional and, of course, cited prior Patents, taking the position that the claims were not patentable over these cited references in view of the indefiniteness therein.[7] After approximately two years of prosecution, and when no claims had been allowed to Jones, the Patent Office drafted an allowable claim on its own

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[4] R. p. 315, Pltf's. Exh. 2, p. 8.

[5] R. pp. 314-315, R. p. 382, Pltf's. Exh. 14, photo R. p. 295 (showing model).

[6] R. p. 319, letter R. p. 382, paragraph 3. See also, R. p. 209 where petitioners' expert admits there was no legal compulsion to file another application.

[7] It is apparent from a brief review of the File Wrapper of the Patent in suit, Pltf's. Exh. 2, that each action by the Patent Office included a rejection on indefiniteness.

initiative and suggested that Jones place this claim (now claim 1 of the Patent) in his application for purposes of an Interference proceeding.[8] Jones copied the claim,[9] and an Interference was set up. One of the parties to the Interference moved to dissolve the Interference on the grounds that the claim drafted by the Patent Office was not patentable and presented a strong argument to this effect; the Motion, however, was dismissed.[10] Thereafter, since all of the other parties in the Interference with Jones had filing dates long subsequent to Jones' filing date, these other parties were forced to concede priority of invention to Jones, thereby terminating the Interference in Jones' favor.[11]

Following the termination of the Interference Proceeding, Jones continued his attempt to obtain allowable claims broader than the claim suggested by the Patent Office,[12] but was primarily rejected by the Patent Office Examiner on the ground of indefiniteness. On appeal of the rejection to the Patent Office Board of Appeals, the Board affirmed the rejection of certain claims in the application on indefiniteness, but eliminated all rejections theretofore made on the basis of prior art and anticipation.[13] Upon remand of the application to the Examiner for further prosecution consistent with the Board's decision, the rejection was singularly limited to indefiniteness. Accordingly, Jones' local attorney instructed his patent associate in Washington, D. C. to conduct an interview at the Patent

[8] Pltf's. Exh. 2, File Wrapper of Jones Patent, p. 30, Paper No. 10.

[9] Ibid., p. 31, Paper No. 11.

[10] Ibid., p. 35, p. 40, Paper No. 14, p. 3.

[11] Ibid., p. 38, Paper No. 14, p. 32, Paper No. 12

[12] Ibid., see amendments filed, 9/7/48 (pp. 38-41); filed 3/3/49 (pp. 44-58) and Appeal filed 3/21/49 (pp. 55-57).

[13] Ibid., pp. 90-91 (decision of Board of Appeals, Paper No. 34).

Office in order to obtain an allowable claim substantively consistent with prior claims presented, but not subject to prior rejections on indefiniteness. The instructions to the associate made it clear that the claim should expressly read on both models of Jones' invention, i.e., the model which Jones initially brought to his attorney and the model which Jones made initially having the "reversed parts".[14]

(D) Claim Covering Both Models Allowed By Patent Office—Licenses Sought and Taken By Two Manufacturers From Date of Allowance of Patent

As a result of the conference with the Examiner, a Claim 26 was entered in the application,[15] and when Jones learned of the allowance of this Claim (now Claim 5 of the Patent), with other previously allowed claims, he advised Seymour Smith & Company, a then existent manufacturer of the Jones invention, of the allowance, and Smith Company in return **urged** cooperation and its desire for a license.[16] Jones had also contacted the only other then existent manufacturer (Bashford of California) of a wrench of the type in question embodying the Jones quick release feature, and, after some negotiations, both then existent manufacturers took licenses.[17]

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[14] R. p. 295, Pltf's. Exh. 14. The attorney was trying from the outset to obtain a claim of this scope, and the attorney as well as Jones believed the broad claims afforded this protection. (See letter, R. p. 382, paragraph 3). This statement by the attorney was unnecessary in this letter—i.e., there was no reason or necessity for making it to the Washington associate.

[15] Pltf's. Exh. 2, p. 102, Paper No. 37. Also see Claim 24 submitted 3/3/49, p. 47, Pltf's. Exh 2.

[16] See letters of Smith Co., R. pp. 649, 651, 652, 657, 661 ("we wish to state that we are interested and anxious to cooperate in this matter."), pp. 667, 675, 678.

[17] See License Agreements, R. pp. 675, 678, 679.

(E) Respondent Petersen Saves Inventor From Defaulting Licensees

A few years after Jones' Patent issued, and after the Jones invention had been marketed by the licensees referred to above, the Petersen Manufacturing Company of DeWitt, Nebraska (one of the Respondents herein) became interested in marketing a wrench with a quick release lever thereon. Petersen requested its attorneys to make a search of the patent records to ascertain if the release lever construction which it proposed to manufacture, would be an infringement of any patent. The search developed the Jones patent, now in suit, and Petersen thus sought a license thereunder.[18]

At the time Petersen sought the license, Jones' prior licensees were in arrears in their payments to Jones. For this reason, among others, Jones was legitimately most dissatisfied with them.[19] When Petersen offered Jones a license arrangement, Jones cancelled the prior licenses due to the licensees' violations, and entered into an exclusive license arrangement with Petersen.[20]

(F) Petitioner Sears Buys Respondents' Wrench for Purpose of Making and Selling a Competitive Structure—Petitioner Parker Makes Model of Jones Wrench With Parts Merely Reversed From Model Sold By Respondent Petersen. Court Finds Petitioners' Model Within Patent Claims Expressly and Implicitly

After Petersen had marketed its quick release plier-type toggle wrench, as constructed in accordance with the preferred embodiment of the Jones patent, under the license from Jones, the hardware buyer for Petitioner Sears, Roebuck, knowing of Sears' prior failure and abandonment of

[18] R. pp. 136, 137, 154.

[19] R. pp. 154, 828-841.

[20] See License Agreement, R. p. 389.

a different type of so-called quick release wrench,[21] purchased a Petersen wrench with the Jones' quick release thereon, and after noticing the successful operation thereof,[22] suggested that Petitioner Parker observe the same. Petitioner Sears requested that Petitioner Parker manufacture for Sears a quick release wrench competitive with Respondents' quick release wrench.[23] Parker devised several alternatives of quick releases, most of which were far removed from the Respondent Jones Patent.[24] However, one of the devised types of quick releases was applied to Petitioners' wrench here in suit, and it was this device—the closest of the Parker alternatives to the Jones construction and the Petersen product—which Parker manufactured and Sears, Roebuck sold.[25] It was this device that differed from the Petersen model by only reversing the quick release parts thereof, a feature now admittedly literally covered by one of the claims;[26] it was this device that in fact was found by the Court to also infringe other claims of the Jones patent by applying even the most minimal range of equivalents.

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[21] See R. p. 415 where Maerlander admits designation of prior structure as a "quick release" is a misnomer.

[22] R. p. 444 (Maerlander).

[23] R. p. 445 (Maerlander). Petitioners assert Parker made an independent development, but even the chief Parker engineer admits he knew of the Petersen wrench with quick release and the Seymour Smith wrench before Parker's production, R. p. 229.

[24] See opinions given Parker by counsel, R. pp. 25, 26.

[25] Structure in suit is referred to in opinions (Footnote 24) as one with release lever pivoted on toggle link.

[26] The admission is implied in Petitioners' Petition herein, and is expressly acknowledged at p. 20 of Petitioners' Brief filed in the Court of Appeals.

(G) Petitioners' Attorney Gives Erroneous Opinion as to Infringement—Claim of Patent Admittedly Reads Literally on Accused Structure Within Most Limited Express Meaning of Words Thereof

Parker consulted its Patent Attorney with respect to the wrench in suit, and was advised of the Jones patent.[27] The attorney rendered an opinion as to the patent and the various devices proposed by Parker on the same day that he received the Parker models and at a time when an opinion of non-infringement was essential to Parker's receiving a large Sears contract for the manufacture of a quick release wrench.[28] The opinion contained an obvious and now admitted error in claim interpretation and, apparently, it is this error which resulted in the instant proceeding.[29] In brief, the opinion ignored Claim 5 of the patent, when in fact claim 5 admittedly reads on and expressly covers the accused structure.

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[27] R. pp. 25, 29, 32 (Letters).

[28] See R. p. 25, first paragraph of letter; also see explanation, R. pp. 37-39.

[29] Opinion states Claim 5 does not read on Parker wrench, but Petitioners now admit Claim 5 does read on Parker wrench. See fn. 26.